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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/022,010	12/13/2001	Scott Derner	400.119US01	2780
7590 11/22/2004 FOGG SLIFER & POLGLAZE, P.A. Attn: Daniel J. Polglaze P. O. Box 581009 Minneapolis, MN 55402			EXAMINER TORRES, JOSEPH D	
			ART UNIT 2133	PAPER NUMBER

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/022,010

Applicant(s)

DERNER ET AL.

Examiner

Joseph D. Torres

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 and 15-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14 and 24-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group III, claims 9-14 and 24-26 in the reply filed on 08/11/2004 is acknowledged.

This application contains claims 1-8 and 15-23 drawn to an invention nonelected without traverse on 08 April 2004. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 1-8 and 15-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected claims, there being no allowable generic or linking claim. Election was made **without** traverse on 08 April 2004.

### ***Drawings***

2. The drawings were received on 08/11/2004. These drawings are accepted.

### ***Claim Objections***

3. In view of the amendment received on 08/11/2004, all objections to the claims to the claims are withdrawn.

***Response to Arguments***

4. Applicant's arguments filed 08/11/2004 have been fully considered but they are not persuasive.

The Applicant contends, "As defined in the specification, a ROM embedded DRAM has sections of DRAM cell structures that are programmed as ROM cells and sections of DRAM cells that function as DRAM cells. In contrast, the DRAM cells of the McConnell et al. reference are all used as redundant replacements for ROM cells, or are not used at all".

In response to applicant's arguments, the previously quoted recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The Examiner would like to point out that even if the claims were amended to included language from the preamble, col. 2, lines 40-67 and col. 1, lines 60-67 in McConnell explicitly teach that a DROM is a memory device with a ROM section built out of DRAM cells and embedded in DRAM so that some of the DRAM cells still function as DRAM, hence DROM is ROM embedded DRAM; Note: in Figure 1 of McConnell memory cells 11 and 13 are ROM cells and memory cells 12 are DRAM cells, hence the ROM section

built out of DRAM cells is ROM embedded DRAM which has a section of DRAM used as ROM and a section of DRAM cells still functioning as DRAM. Col. 2, lines 40-67 and col. 1, lines 60-67 in McConnell explicitly teach that the cells are programmed as ROM by removing electrical connections so that data can only be read once the ROM cells are programmed.

The Applicant contends, "Claim 10 recites 'correcting if the decoded ROM bit differs from the read ROM bit.'" This is not done in McConnell et al., which only discusses error correction for a determination of whether DRAM cells that are being used as a redundancy for ROM cells have the correct data therein, or whether the ROM cells have been replaced with DRAM cells in a redundancy operation". The Examiner asserts that nowhere does McConnell et al discuss "error correction for a determination of whether DRAM cells that are being used as a redundancy for ROM cells have the correct data therein, or whether the ROM cells have been replaced with DRAM cells in a redundancy operation" nor is it clear how error correction which is used to correct data can be used for such an operation. Instead col.4, lines 32-37 in McConnell explicitly teach that parity error correction information is used to reconstruct or correct the data stored in the ROM embedded DRAM memory taught in the McConnell patent.

The Examiner disagrees with the applicant and maintains all rejections of claims 1-20. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 1-20 are not patentably distinct or non-obvious over

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the prior art of record in view of the reference, McConnell; Roderick et al. (US 5986952 A, hereafter referred to as McConnell) as applied in the last office action, filed 05/11/2004. Therefore, the rejection is maintained.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 9-14 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over McConnell; Roderick et al. (US 5986952 A, hereafter referred to as McConnell).

See the Non-Final Action filed 05/11/2004 for detailed action of prior rejections.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph D. Torres, PhD  
Primary Examiner  
Art Unit 2133

